

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claim 8 been amended. No new matter has been added.

This amendment changes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-20 are now pending in this application.

Rejections under 35 U.S.C. §§ 102 and 103

Claims 8-9 and 13-18 stand rejected under 35 U.S.C. § 102(a) or (e) as being anticipated by U.S. Patent No. 6,685,829 to Baumann et al. ("Baumann"). Claims 10-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Baumann. Claims 1-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,902,479 to Fukumori et al. ("Fukumori") in view of U.S. Patent No. 5,711,872 to Jones et al. ("Jones"). Claims 5-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukumori in view of Jones, and further in view of U.S. Patent No. 5,066,391 to Faria et al. ("Faria"). Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Baumann in view of Faria. Claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Baumann in view of U.S. Patent No. 5,584,987 to Mules ("Mules"). Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Baumann in view of U.S. Patent No. 5,525,225 to Janik et al. ("Janik"). Applicant respectfully traverses these rejections for at least the following reasons.

Independent claim 1 recites "an inner tubular member disposed in the recessed portion of the cover so as to be movable into and out of the recessed portion". The Office Action recognizes that Fukumori does not disclose this feature, but relies on Jones for disclosing an inner tubular member disposed in a recess portion of a cover. Applicants submit that Jones fails to cure the deficiencies of Fukumori.

In contrast to claim 1, Jones fails to disclose an inner tubular member disposed in a recessed portion of a cover. The Office Action equates the housing 18 and bale 21 of Jones with the inner tubular member and cover, respectively, as recited. The bale 21 of Jones, however, is not shaped as a cover, as can be clearly seen in FIG. 9 of Jones. The bale 21 of Jones functions to help hold the housing 18 to an adaptor 12 for holding the filter including the housing to an engine block 37. Jones merely discloses that a filter, including a housing 18, can be held to an adapter using a bale 21, but does not suggest an inner tubular member that is biased within its filter. Even if there were motivation to combine Fukomori and Jones, the result would be the inclusion of a bale on the outside of the Fukomori housing to help hold the Fukomori filter, not a tubular member within the filter. Thus, even if Jones and Fukomori were combined, the result would not meet the limitations of claim 1.

Independent claim 20 recites “an inner tubular member disposed in the recessed portion of the cover so as to be movable into and out of the recessed portion”, and thus is patentable for reasons analogous to claim 1 discussed above. Moreover, claim 20 additionally recites “wherein the cover has an oil collecting portion at a bottom side outer circumferential periphery thereof.” The Office Action acknowledges that Fukomori and Jones fail to suggest this feature, but relies on Janik as disclosing an oil collecting portion as recited. Specifically, the Office Action equates the element 60 of Janik with the oil collecting portion. The circumferential roll portion 60 of Janik is provided for attachment of the filter cartridge 14 to the base 12 of the Janik device. The circumferential roll portion 60, however, cannot serve as an oil collecting portion because the bottom of the Janik filter cartridge includes a drain plug, and thus when the filter cartridge is changed, the oil inside the cartridge would first be drained prior to removal from the base.

Independent claim 8, as amended, recites “wherein the biasing unit holds the partition member pressed against the housing main body so that the volume of the oil suction chamber increases as the cover is moved increasingly away from the housing main body upon removal of the cover.” Baumann, which the Office Action relies on for the rejection of claim 8, fails

to suggest this feature of claim 8, nor would it have been obvious in light of the structure and purpose of the Baumann device.

Baumann discloses, in FIGs. 3a and 3b, a filter 1 with a filter bypass valve 11 formed of a collar 19 and an upper end disk 21. When excess pressure exists in the filter, filter insert 4 is pressed downward, opening the filter bypass valve 11 (col. 4, lines 16-22). The motion discharges a dome 9 downward against the action of spring 10.

The Office Action equates the spring 10, collar 19, cover 3, and housing 2 of Baumann with the biasing unit, partition member, cover, and housing main body, respectively, as claimed. In contrast to claim 8, however, the spring 10 does not press the collar 19 against the housing 2 as the cover 3 is moved away from the housing 2 upon removal of the cover 3. Instead, as can be seen in FIGs. 3a and 3b, the spring 10 is arranged so as to bias the collar 19 toward the cover 3 when the cover 3 is removed. Thus, Baumann fails to anticipate claim 8.

Moreover, it would not have been obvious to have modified Baumann to arrive at the invention as claimed in claim 8. The purpose of the collar 19 in Baumann is to function as part of a bypass valve in the Baumann device such that when the pressure becomes too high, the valve opens against the bias of spring 10. Modifying the Baumann device such that the bias was in the opposite direction would have rendered the Baumann device unfit for its intended purposed, and one skilled in the art would not have done so.

The dependent claims ultimately depend from one of claims 1 and 8, and are patentable for at least the same reasons, as well as for further patentable features recited therein.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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